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09/468,611	12/21/1999	ERIC B. REMER	42390.P7278	3835

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EXAMINER
HAYES, JOHN W

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HW

Office Action Summary	Application No. 09/468,611	Applicant(s) REMER ET AL.	
	Examiner John W Hayes	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-7,9,10,13,25,27-29 and 31-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-7,9,10,13,25,27-29 and 31-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 December 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1-2, 4, 10, 13, 25, 27 and 32-34 and canceled claims 3, 8, 26 and 30 in the amendment filed 04 April 2003. Applicant has previously canceled claims 11-12 and 14-24. Thus, claims 1-2, 4-7, 9-10, 13, 25, 27-29 and 31-34 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments filed 04 April 2003 have been fully considered but are not persuasive or moot in view of the discussion below and the new grounds of rejection.

3. Examiner agrees with applicant's argument that Misra discloses a license server that determines whether the client is authentic and grants a new license if the client is authentic. Applicant also asserts that Misra does not disclose determining, by the first computer, whether a second license is authentic. Examiner respectfully disagrees with this assertion and notes that Misra discloses that the license server digitally signs the software license and encrypts it using the client's public key suggesting that the digital signature is used to authenticate the license server as well as the license. Furthermore, examiner submits that it was a well known practice in the encryption art at the time of applicant's claimed invention to use digital signatures and hashing functions to authenticate the origin of digital information as well as authenticating the actual information to ensure that the information has not been altered or tampered with.

4. Applicant further contends that Gradient does not disclose determining, by the first computer, whether a second license authentic, however, examiner has not relied upon Gradient for this teaching. Examiner submits that Misra discloses this feature, or at least would have been obvious to one having ordinary skill in the art in view of the teaching by Misra of digitally signing the software license and encrypting it when sending the license to the client in accordance with the discussion above.

Applicant further asserts that there is no motivation suggested in the prior art for combining the references of Misra and Gradient and also submits that the mere fact that the prior art could be modified to form the claimed structure, the modification would not be obvious unless the prior suggested the

desirability of such a modification. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner respectfully disagrees with applicant's assertion and submits that Gradient provides the motivation for generating a license by the end user (first computer) such as a demo license and then later purchasing an operational license (second license) for installation. The previous office action included rational for combining Misra with Gradient based on the motivation discussed within the Gradient reference. Gradient specifically indicates that providing this capability revolutionizes the economics of software fulfillment and licensing and offers advanced tools that lower the cost of license creation and delivery and provides end users with complete control over their software purchase and deployment decisions (Paragraph 4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 4-7, 9-10, 13, 25, 27-29 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al, U.S. Patent No. 6,189,146 B1 in view of Gradient, "Gradient Introduces End User Software License Creation and Delivery Tool For Its iFOR/LS Licensing Technology, dated 21 March 1994 and Bains et al, U.S. Patent No. 5,579,222.

As per **Claims 1, 13 and 33-34**, Misra et al discloses a method for licensing software comprising:

- generating a first license for software installed on the first computer (Col. 2, lines 62-67; Col. 3, lines 22-25; Table 1; Col. 11, lines 45-51; Col. 12, lines 8-14);

- obtaining, by a first computer, from a second computer a second license for software installed on the first computer, wherein the second license is generated by the second computer (Col. 2, lines 48-55; Col. 4, lines 54-59; Col. 8, lines 35-67; Col. 12, lines 20-27; Col. 14, lines 8-14 and 49-53);

- determining, by the first computer, whether the second license is authentic (Col. 15, lines 29-49), and

- replacing, if the second license is authentic, the first license with the second license (Col. 15, lines 37-49; Col. 16, lines 49-67);

- selectively refreshing the second license prior to expiration of the second predetermined period of time (Col. 14, lines 14-51; Col. 16, lines 49-67).

Misra et al discloses the generation of a first license on a license generator computer which is the same license generator that generates the second license as well, however, fail to explicitly disclose that a first computer generates the first license. Gradient discloses a license delivery and installation tool the enables end users to create software licenses on their own system without outside intervention and further teach that end users can create their own "try and buy" demo licenses for software and later, if the user chooses to purchase an operational license, the desired license type may be selected from an options menu and installed. Gradient teaches that authorized end users are able to instantly create short-term licenses and allows end users, working at their own PC, to select from a variety of licensing options and to create licenses that are installed within a single user's workstation or PC. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Misra et al and include the ability to allow a first computer such as a end user to create their own license and store this license on the first computer wherein the license is valid for a predetermined short-term period of time as taught by Gradient. Gradient provides motivation by indicating that this capability revolutionizes the economics of software fulfillment and licensing and offers advanced tools that lower the cost of license creation and delivery and further provides end users with complete control over their software purchase and deployment decisions.

Bains et al also disclose a distributed license administration system wherein a local policy server daemon operates as the local computer node to grant a first temporary license for a software product to be used on the computer node (Col. 3,lines 48-65; Col. 4, lines 3-20; Col. 5, lines 38-45 and 55-62; Col. 7, lines 12-16). Thus, it also would have been obvious to modify the method of Misra et al and include the ability to allow the first computer to generate or grant a license for use of a software product on the first computer as taught by Bains et al. Bains et al provides motivation by indicating that this would allow users to obtain licenses for software products when a particular license server is unavailable or non-operational.

As per **Claims 2 and 25**, Misra et al further disclose

- setting, by the first computer, a first identifier to associate the first license with the first computer (Col. 9, lines 29-61; Col. 10, lines 51-59; Col. 12, lines 41-67);

- matching the unique identifier of the second license to the unique identifier of the first license, and if no matching occurs, discarding the second license without replacing the first license (Col. 11, lines 45-65; Col. 11 line 66-Col. 12 line 7; Col. 14, lines 30-39), and

- authenticating the digital signature of the second license, and if authentication fails, discarding the second license without replacing the first license (Col. 12, lines 8-15);

- replacing the first license with the second license if the second license is determined to be authentic (Col. 16, lines 39-67).

As per **Claims 10 and 32**, Misra et al further disclose wherein the first and second licenses are digitally signed (Col. 13, lines 42-63; Col. 14, lines 25-38).

As per **Claims 4 and 27**, Misra et al further disclose wherein obtaining from the second computer the second license further comprises:

- connecting to the second computer (Col. 14, lines 14-16)

- providing the second computer with at least some of the data from the first license (Col. 14, lines 24-30)

- exchanging the provided data from the first license for the second license (Col. 14, lines 49-53; Col. 15, lines 11-18 and 37-49).

As per **Claims 5-6 and 28-29**, Misra et al further disclose wherein connecting to the second computer comprises connecting to the second computer via a communications network (Col. 4, lines 43-49).

As per **Claim 7,** Misra et al disclose all the limitations of claim 5, however, fail to specifically disclose wherein exchanging the first license for the second license includes formatting data from the first license according to a set of text processing rules and transmitting the formatted data using a text transfer protocol. Examiner takes Official Notice that formatting data according to a set of text processing rules such as HTML or XML and transmitting the formatted data using a text transfer protocol such as HTTP was well known in the art at the time of applicants invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use text processing rules such as HTML for formatting data and use a text transfer protocol such as HTTP for exchanging data since these formats and protocols were commonly used, especially in Internet communications since they were readily available and convenient to use.

As per **Claims 9 and 31**, Misra et al disclose verifying whether the replaced license is valid, including determining whether the replaced license has expired (Col. 14, lines 30-48).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Horstmann discloses that an end user's machine is installed with a license certificate which typically is installed during original installation of a software product and further including a relicensing manager
- Ross et al disclose a method and apparatus for electronic licensing in a network environment to facilitate product licensing and upgrades
- Coley et al disclose an automated system for management of licensed software and enabling or disabling the software accordingly
- Griswold discloses a license management system that periodically invokes a license check monitor to ensure valid usage of software and terminates use of the software is appropriate
- Horstmann discloses a method of relicensing of electronically purchased software
- Knutson discloses a method for licensing computer programs using DSA signature
- Carter et al disclose a method for network license authentication
- Cohen discloses a method for software licensing electronically distributed programs

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703)305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

John W. Hayes

Primary Examiner
Art Unit 3621

June 3, 2003